



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 3723

Art Examiner: Anthony Eziamara OJINI

Handwritten: 3
C/NB
#9 10/10/03

Re PATENT APPLICATION Of:

Applicant(s): Patrick Michael McCaffrey et al.

Serial No.: 09/840,077

Filed: April 24, 2001

For: POWDER FOR DISKS

Atty Ref.: IBM 204

REQUEST TO
WITHDRAW THE
FINALITY OF THE
ACTION AND
PROVISIONAL PETITION

RECEIVED

October 3, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450 TECHNOLOGY CENTER R3700

OCT 10 2003

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OCT 07 2003

GROUP 3600

Sir:

It is respectfully requested that the finality of the Examiner's Action dated September 24, 2003, be withdrawn and the period for response restarted, because Applicants have not amended claim 9 in a manner which would have necessitated the new grounds of rejection.

In the first Examiner's Action dated September 10, 2002, the Examiner rejected dependent claim 9 (as well as other claims) as being obvious in view of Tolles et al. (USP 5,7838,574).

In Applicants' response filed November 22, 2002, Applicants amended dependent claim 9 into independent form by including only the subject matter of base claim 1, there being no intervening claims. This amendment did not change the scope of claim 9 in any manner. Applicants also argued the allowability of this claim over the cited reference.

In response, the Examiner undertook a new search, and issued a second office action on April 17, 2003. In this second, non-final office action, the Examiner withdrew the previous rejections, and rejected claim 9 (as well as other claims) in view of the newly cited Abiko patent (JP 10208301).

In Applicants' response filed June 20, 2003, Applicants argued the allowability of claim 9 over the cited reference. No amendments to claim 9 were made at this time.

In response, the Examiner undertook a yet another new search, and issued a third office action on September 24, 2003. In this third, final office action, the Examiner withdrew the previous rejections, and rejected claim 9 (as well as other claims) in view of the previously cited Abiko patent (JP 10208301) in combination with the newly cited Kobayashi patent (USP 6,601,289). The Examiner's Action stated that Applicants' amendment necessitated the new ground of rejection.

Applicants' counsel attempted to contact the Examiner on September 26, 2003, requesting that the finality of this action be withdrawn as being premature. Although a voice mail message was left for the Examiner, Counsel's phone call was not returned. Applicants' counsel then contacted the Examiner's supervisor on September 30, 2003, who suggested that this petition be filed.

It is initially noted that the MPEP 706.07(a) states:

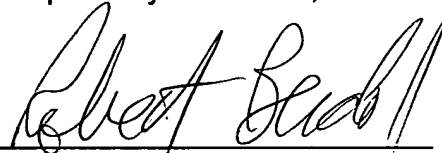
"...[that a] second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Since Applicants have neither amended claim 9 in a manner that would necessitate a new ground of rejection, nor submitted any information disclosure statements, if the

United States Patent and Trademark Office follows the guidelines set forth in the MPEP, then the Examiner's Final Action is improper. It is thus respectfully submitted that the present Action constitutes a premature final action and it is requested that the finality of this Action be withdrawn, and that the period for response be restarted.

Should the Examiner maintain the finality of this Action, it is requested that this request be considered a Petition to the Commissioner to exercise his supervisory authority, and withdraw the finality of the Action. It is not believed that any fee is due for such a Petition. However, authorization is given to charge our deposit account number 18-0002 for any fees that may be due for such Petition.

Respectfully submitted,



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October 3, 2003
Date

RHB:crh